

### **REMARKS**

This is a full and timely response to the non-final Office action mailed July 28, 2011. Claims 1-13 and 15-18 are pending in this application. Claims 9 and 15 are amended herein. No new matter is added by this amendment. Reconsideration of this application in view of the foregoing amendments, the New Declaration and Supplemental Declaration filed concurrently herewith, and the following remarks is earnestly solicited.

#### **Objection to the Declaration**

The reissue declaration is objected to for failing to identify at least one error relied upon to support the reissue application. A new declaration signed by the inventors and complying with all the requirements outlined by the Examiner is submitted herewith.

More particularly, the new declaration specifically states that "Patent No. 6,340,137 is wrong and contains an error." With regard to the error, the new declaration states that "the language in Claim 1 relating to a plurality of sensors, force signals, and a control system is partly inoperative by reason of the patentee claiming less than he (they) had a right to claim."

The Examiner further states that the reissue oath/declaration is defective because the "reviewed and understand" language does not expressly contemplate all amendments made since the filing of the reissue application. In accordance with the Examiner's suggestion, the aforementioned new declaration includes a "reviewed and understand" statement which expressly contemplates "all amendments to date". Applicants respectfully submit that the aforementioned new declaration fully complies with 37 CFR 1.175(a)(1) and section 1414 of the Manual of Patent Examining Procedure (MPEP).

The Examiner further states that a supplemental declaration should be filed which includes an updated "no deceptive intent" statement to cover the changes made by amendments filed subsequent to the previously filed declaration. For this purpose, also filed concurrently herewith is a separate, supplemental declaration signed by the inventors and which includes a "no deceptive intent" statement covering amendments subsequent to the previously filed declaration. Applicants respectfully submit that the aforementioned supplemental declaration also fully complies with 37 CFR 1.175(a)(1)

and section 1414 of the Manual of Patent Examining Procedure (MPEP).

**Claim Rejections Under 35 U.S.C. 251**

Claims 9 – 13 and 15 – 18 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Claims 1 – 13 and 15 - 18 are further rejected under 35 U.S.C 251 as being based upon a defective reissue declaration for the reasons set forth above in connection with the reissue oath/declaration previously filed in this application. As noted above, corrective new and supplemental declarations are submitted concurrently with the filing of this Response. Accordingly, Applicants respectfully request withdrawal of the foregoing claim rejections based on a defective oath/declaration.

With respect to the rejection of claims 9 – 13 and 15 – 18 based on recapture, the Examiner states that Applicants' arguments in the parent application as to why claims 1, 5, and 6 are allowable mean that the associated claim limitations are considered *surrender generating limitations*. The Examiner then asserts that these limitations "must be retained and not broadened (retained essentially word-for-word) in reissue claims 9, 15."

Applicants agree that arguments and amendments made in the parent application may constitute surrender generating limitations under certain circumstances. However, even assuming, *arguendo*, that the amendments/arguments made in the parent application relating to a plurality of force sensors, force signals, and/or a control system may give rise to surrender generating limitations, Applicants respectfully disagree that any such limitations must be retained word-for-word in the reissue claims. Indeed, MPEP section 1412.02 discusses the effect of such surrender generating limitations in detail, and guides the Office and applicants in the proper procedures for amending reissue claims without running afoul of the recapture doctrine.

MPEP 1412.02(I)(C) states, for example, that if the key limitation added to overcome a prior art rejection was "an orange peel", and the reissue claim instead recites "a citrus fruit peel" (i.e., a broader wording of the same element), *the reissue claim may not be rejected on recapture grounds*.

MPEP section 1412.02(I)(C)(2)(d) addresses the particular situation in which a reissue claim is broader in scope in an area directed to amendment/argument made in the parent to overcome a prior art rejection, but the reissue claim retains, in broadened form, the limitation(s) argued/added to overcome the rejection. To illustrate, assume the combination AB was originally claimed in the parent, and was amended in reply to an art rejection to add element C to thus provide the combination ABC in the issued patent. In the reissue application, the combination ABC' is proposed, where C' is a broadened recitation of element C. Even though the combination ABC' is broader than the combination ABC in the issued patent, "[t]here is no recapture" since the combination ABC' "is narrower than canceled claim subject matter AB in an area related to the surrender." MPEP 1412.02(1)(C)(2)(d), citing *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential) (emphasis in original).

In the present case, the claims were amended in the parent application to include language relating to a plurality of sensors, signals indicative of forces in the struts, and/or a control system connected to receive force signals from the sensors. In this reissue application, Claim 9 (analogous to original Claim 1) is amended herein to recite "at least one sensor configured to provide a signal indicative of said resultant torque to said control system." Claim 15 is amended to recite "a sensor configured to provide a signal associated with said resultant torque to said control system." As amended herein, Claims 9 and 15 each include a broader recitation of the originally added elements. Accordingly, Claims 9 and 15 are not subject to the recapture doctrine. Applicants therefore respectfully request that the rejection under 35 U.S.C 251 be withdrawn.

The foregoing amended claim language is supported in the specification, for example, at Column 3, lines 56 – 64 and in Claims 1, 5, and 6 of the original patent. No new matter is introduced by this amendment.

**Conclusion**

Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration and withdrawal of the pending objections and rejections, and an early Notice of Allowance, are earnestly solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

If for some reason Applicant has not paid a sufficient fee for this Response, please consider this as authorization to charge Ingrassia, Fisher & Lorenz, Deposit Account No. 50-2091 for any fee which may be due.

Respectfully submitted,

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